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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,324	12/02/2003	Karl L. Ginter	7451.0005-04	6224
22852	7590	12/07/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SHAN, APRIL YING	
			ART UNIT 2435	PAPER NUMBER
			MAIL DATE 12/07/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/727,324

**Applicant(s)**

GINTER ET AL.

**Examiner**

APRIL Y. SHAN

**Art Unit**

2435

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-39, 41-59, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) 42-59, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-39 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The Applicant's amendment, filed 27 August 2009, has been received, entered into the record, and respectfully and carefully considered.
2. As a result of the amendment, claims 21-24, 26, 30, 35, 38-39 and 41 have been amended. Claims 1-20, 40 and 60-61 have been canceled. Claims 42-59 and 62-63 have been withdrawn from consideration. Thus, claims 21-39 and 41 have been examined.
3. Any objection/rejection not repeated below is withdrawn due to applicant's argument/explanation/amendment.
4. Please note "sending, from the first electronic appliance to the second appliance, the second digital certificate" is a newly added claim limitation.

***Priority***

5. Acknowledgment is made that the instant application is a continuation of Application No. 08/699,712, filed 08/12/1996, now abandoned, which is a continuation-in-part of Application No. 08/388,107, filed 02/13/1995, now abandoned.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 21-23, 26-27, 29, 32-33, 36-39 and 41 are rejected under 35 U.S.C.

103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Cheng et al. (U.S. Patent No. 5,544,322).

As per **claim 21**, Sudia discloses a method for providing access to an online service ("...electronic commerce business" – e.g. col. 4, lines 52-53), the method comprising:

receiving, at a first electronic appliance (a recipient user – e.g. col. 9, line 36), a first digital certificate from a second electronic appliance associated with a user (a sending user – e.g. col. 9, line 37) the first digital certificate attesting to at least one attribute of the user ("receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user" – e.g. claim 1);

determining, by the first electronic appliance, based at least in part on the first digital certificate, whether the user is authorized to access the online service ("When a recipient user (verifier) receives a transaction 51 from a

sending user, the recipient first uses the sender's basic key certificate 55 to verify the sender's signature 52 on the transaction..." – e.g. col. 9, lines 36-40);

issuing, by the first electronic appliance, based on the determination of whether the user is authorized to access the online service, a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service ("receiving a digital authorization certificate, separate from said identifying certificate and issued by a sponsor of said user, and authorizing transactions by said user..." - e.g. claim 1, "...the recipient also uses the sender's authorization certificate 56, signed by the sender's sponsor 59, to verify..." – e.g. col. 9, lines 36-45) and collecting, by the first electronic appliance, information relating to the user's use of the online service (user transaction 1202 in fig. 12 and col. 13, lines 9-10. Please note user transaction corresponds to Applicant's information relating to the user's use of the online service)

Please note further in col. 14, lines 5-18, Sudia also discloses "...it may often be helpful to the copy the user's public key out of his basic authentication certificate and include it as another attribute in an authorization certificate. This permits the authorization certificate to serve both purposes (authentication and authorization) and allows the sender to omit the basic authentication certificate from each transaction". It is clear that in the Sudia reference, the authentication and authorization certificates are either two separate certificates or one authorization certificate to serve both authentication and authorization purposes.

Although Sudia discloses receiving a digital authorizing certificate, separate from said identifying certificate and issued by a sponsor of said user (e.g. claim 1), Sudia does not explicitly disclose sending, from the first electronic appliance to the second appliance, the authorizing/authentication certificate (i.e. second digital certificate), however, Cheng et al. met the claim limitation by disclosing authentication server III waits for authentication request IV from client II (see step c3 below), and constructs and sends authentication certificate V to client II (e.g. col. 9, lines 1-3 of Cheng et al. Please note authentication server corresponds to Applicant's first electronic appliance and client II corresponds to Applicant's second electronic appliance).

Sudia - Cheng et al. are analogous art because they are from a similar field of endeavor in authorizing online service via digital authentication/authorization certificate. Thus, it would have been obvious to a person with ordinary skill in the art, at the time of invention, to modify the teachings of Sudia with sending, from the first electronic appliance to the second appliance, the authorizing/authentication certificate (i.e. second digital certificate) taught by Cheng et al. in order to conform to the received authentication path (e.g. Cheng et al., col. 3, line 45).

As per **claims 22-23**, Sudia further discloses receiving a request from the user to access the online service ("...electronic commerce business" – e.g. col. 4, lines 52-53); checking the second digital certificate to determine whether the user has permission to access the online service ("verifying said transaction based on

information in said identifying certificate and in said authorization certificate, said step of verifying including applying said rules...to verify..." - e.g. claim 1); and allowing the user to access the online service if it is determined that the user has permission to access the online service ("accepting said transaction based on said outcome of said verifying..." - e.g. claim 1) and in which said checking step is performed in a protected processing environment at a local computer system from which the user made the request to access the online service ("a system for securely using digital signatures in a commercial cryptographic system..." - e.g. abstract).

As per **claims 26-27**, Sudia further discloses providing a third digital certificate to the user, the third digital certificate attesting to the identify of the online service, the third digital certificate being issued by a certifying authority (e.g. col. 3, lines 48-67, col. 4, lines 10-38) and in which the first digital certificate is issued by the certifying authority ("receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user" - e.g. claim 1).

As per **claim 29**, Sudia further discloses in which the first digital certificate identifies a party responsible for paying for the user's access to online services (identifying said user - e.g. claim 1 and "user name" of user basic certificate of fig. 5)

As per **claim 32**, Sudia further discloses in which the second digital certificate attests to the user's permission to access the online service until a

specified date ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claim 33**, Sudia further discloses in which the at least one attribute comprises an indication of the amount of purchases the user is allowed to make in a given time period (e.g. col. 11, lines 11-41).

As per **claims 36-37**, Sudia further discloses in which the online service comprises a subscription ("...into the attribute certificates of the CA and its subscribers.." – e.g. col. 7, lines 37-38) and in which the second digital certificate includes an expiration date of the subscription ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claims 38-39**, Sudia further discloses collecting payment information from the user (e.g. col. 12, lines 1-18) and further comprising: sending the payment information to a financial clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

As per **claim 41**, Sudia further discloses sending the information relating to the user's use of the online service to a usage clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).



9. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Cheng et al. (U.S. Patent No. 5,544,322) and further in view of Arnold (U.S. Patent No. 5,956,408)

As per **claims 24-25**, Sudia – Cheng et al. does not expressly disclose sending software to the user. However, this well known feature is disclosed in col. 1, lines 10-14 of Arnold reference. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Arnold's sending software to the user with Sudia – Cheng et al. since sending software to the user assures security (e.g. Arnold, col. 5, lines 1-14).

Arnold further discloses sending a digital signature for determining the integrity of the software to the user (Arnold, e.g. abstract) and in which the digital signature is bound, at least in part, to the identity of the online service (Arnold, e.g. abstract).

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Cheng et al. (U.S. Patent No. 5,544,322) and further in view of Boulton et al. (U.S. Patent No. 5,537,618)

As per **claim 28**, Sudia discloses a digital identifying certificate issued by a certifying authority and having a plurality of digital fields, at least one of said fields identifying said user (Sudia, e.g. claim 1).

Sudia – Cheng et al. does not expressly disclose in which the first digital certificate includes an indication of the user's age.

However, it is well known at the time of the invention age is an attribute to identify a user. This well known feature is disclosed in col. 37, lines 32-34 of the Boulton et al. reference.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Boulton et al.'s age is an attribute to identify a user into Sudia – Cheng et al. since a user's age is one of the attributes that identifying the user.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Cheng et al. (U.S. Patent No. 5,544,322) and further in view of Doggett et al. (U.S. Patent No. 5,677,955)

As per **claim 30**, Sudia – Cheng et al. does not explicitly disclose sending a request for payment to the party responsible for paying for the user's access to online services and receiving an indication that payment has been received.

However, Doggett et al. met the claimed limitation by disclosing *the payer 12 receives a bill or invoice from the payee and the payer's bank, in turn, transfers funds to the payee's account at the payee's bank, which sends a record of the transaction to the payee with accounts receivable information* (e.g. par. 17, lines 30-57).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Doggett et al.'s sending a request for payment to the party responsible for paying for the user's access to online services and receiving an indication that payment has been received into Sudia – Cheng et al. in order to collect payment of the transaction.

This combination would predictably result a well known collect payment for a service. It has been held that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results.” *KSR.*, 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing *Graham*, 383 U.S. at 12).

12. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Cheng et al. (U.S. Patent No. 5,544,322) and in view of Doggett et al. (U.S. Patent No. 5,677,955) and further in view of Gifford (U.S. Patent No. 5,724,424).

As per **claim 31**, Sudia – Cheng et al. - Doggett et al. does not explicitly disclose steps in which the steps of (a) sending a request for payment and (b) receiving an indication that payment has been received are performed prior to performing the step of sending the second digital certificate to the user.

However, Gifford met the claimed limitation by disclosing *a network payment service is used to authorize the purchase before merchant fulfillment is performed* (e.g. col. 3, lines 24-26. Please note merchant fulfillment is performed corresponds to Applicant's sending the second digital certificate to the user).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Gifford's the steps of (a) sending a request for payment and (b) receiving an indication that payment has been received are performed prior to performing the step of sending the second digital certificate to the user into Sudia – Cheng et al. - Doggett et al. in order to pay before accessing service.

This combination would predictably result a well known collect payment before accessing service. It has been held that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results.” *KSR.*, 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing *Graham*, 383 U.S. at 12).

13. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) in view of Cheng et al. (U.S. Patent No. 5,544,322) and further in view of Rebane et al. (U.S. Patent No. 5,978,567)

As per **claims 34-35**, Sudia – Cheng et al. does not expressly disclose in which the online service comprises an interactive online game.

However, this well known feature is disclosed in the abstract, col. 1, lines 48-64, col. 3, lines 22-31 and col. 8, line 66 – col. 9, line 12. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Rebane et al.’s the online service comprises an interactive online game into Sudia – Cheng et al. since online service comprises an interactive online game is offered electronically and interactively is well known in the art. (e.g. Rebane et al., col. 1, lines 48-64).

Sudia-Rebane et al. further discloses sending software for playing the online game to the user in a secure container (Sudia, - e.g. abstract and Rebane et al. - e.g. col. 9, lines 37-52).

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/  
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